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Andrei Mijiritskii

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS

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BRIARCLIFF MANOR, NY 10510

EXAMINER

HIGGINS, GERARD T

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

04/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

Response to Amendment

1. Applicant's amendment filed 03/23/2009 will not be entered because it raises new issues that require further search and consideration and it also raises issues of new matter.

First, the Examiner notes that the drawing has been entered.

With regard to the objections to claims 2 and 3, the Examiner notes that if the amendment was entered it would have overcome the objections to both claims; however, the proposed changes to claim 3 would raise issues of new matter and also require new search and consideration. The Examiner does not find support for a "fifth substrate layer." There is no specific naming of any of the layers of applicants' invention as a "fifth substrate layer," and therefore it is not clear that applicants' were in possession of a "fifth substrate layer" at the time the invention was made.

Other issues of new matter raised by applicants' amendment are as follows:

- a. The terms "a first portion of the data" and "a second portion of the data" are not supported by the specification as originally filed.
- b. The fact that the first label layer is "provided to a user of the optical disc without label information," that the second label layer is "provided to the user without the label information," and that the third label layer is "provided to the user without the label information" are not supported by the specification as originally filed. The Examiner does find support for stating that a label layer "may

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be personally designed by a user after optical disc manufacture” (see applicants’ specification page 3, lines 1-2).

c. The concept of a “third label layer” is not supported by the specification as originally filed.

d. The concepts of a “first range of wavelengths” and a “second range of wavelengths,” and also that “the second range of wavelengths being different from the first range of wavelengths” are not supported by the specification as originally filed.

e. The concept of a “further label material” is not supported by the specification as originally filed.

f. The concept of a “fourth substrate layer” is not supported by the specification as originally filed; furthermore, it appears that the fourth substrate is now on a different side of the optical disc, given its original location with regard to original claim 14 and its new location with regard to claim 1 presented in this amendment.

g. The fact that the first transparent layer is comprised of a first label layer, a third label layer, a first substrate layer, and a fourth substrate layer is not supported by the specification as originally filed; furthermore, taking these limitations in combination with the limitations of claim 14 renders the claims indefinite and new matter given the fact that the fourth substrate now appears on both sides of the disc and is involved with the first, second, and third label layers.

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h. The concept of a “fifth substrate layer” as stated in claims 3 and 14 is not supported by the specification as originally filed; furthermore, the fifth substrate layer is performing two different functions in the two claims, which leads to further confusion as to whether applicants were in possession of their invention at the time of filing.

Applicants state in regard to the rejection of the claims under 35 USC 112, first paragraph as failing to comply with the written description requirement that “the specification has been amended for better conformance with the claims” (applicants' Remarks page 8).

The Examiner disagrees and notes that there is no specification amendment filed with the concurrent claims and Remarks; furthermore, there would be a question as to whether the specification can be amended to introduce such terms as are in question because they would potentially also constitute new matter.

Applicants then argue that the specification provides support for all of the terms that were present in the claims filed on 09/26/2008.

The Examiner notes that the terms applicants are referring to do not appear anywhere in applicants' specification either throughout or at the places mentioned by applicants; further, the drawings do not necessarily require these terms. It has been held that when an explicit limitation in a claim “is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description **requires** that limitation” (emphasis added). *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d

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1128, 1131 (Fed. Cir. 1998). The description as originally filed does not necessarily require these terms, and therefore the Examiner maintains his rejections.

Applicants argue the rejections under 35 USC 112, second paragraph, particularly with regard to the terms "label material" and "light."

The Examiner disagrees with applicants' arguments because applicants have identified a "label material for forming a first label" as providing antecedent basis for "the label material for forming a second label;" however, a "label material for forming a second label" is clearly different from a "label material for forming a first label," and therefore cannot provide antecedent basis for "the label material for forming a second label" and "the label material for the forming of the first label and the second label" as claimed. Applicants have not established that the two label materials are the same label material; furthermore, given these facts the recitation of "the label material" later on in claim 1 and in claims 3-5 is indefinite for lacking antecedent basis because there are multiple label materials.

With regard to the term "the light," applicants' arguments have been found persuasive to the extent that the term does have antecedent basis in the claim; however, the term is still indefinite because it is unclear whether the "light at a range of wavelengths in the visual spectrum" is the same for the first label and the second label given the fact that they are made from different label materials.

Applicants then argue that the prior art do not teach a "first label layer formed from label material and a third label layer formed from a further label material, where the first label layer and third label layer are separated by a fourth substrate layer."

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First, the Examiner notes again that these terms are not supported by applicants' specification; further, this arrangement would require new search and consideration because the Examiner has not treated this arrangement as previously claimed. Also given the fact that the Examiner is not entering the present amendment, it is clear that the prior art continues to meet the claims; furthermore, even if this amendment was entered the art would still meet the claims because this represents a mere duplication of parts. It has been held that "mere duplication of parts has no patentable significance unless a new and unexpected result is produced." Please see MPEP 2144.04 and *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). The addition of further label layers and further substrates does not produce a new and unexpected result. The result would be completely expected in that one could form more complex three-dimensional images that would be more appealing to a user of the optical disc.

Applicants then argue that the additional limitations that require the label layers to not be provided with label information from the manufacturer define it over the prior art.

The Examiner notes again that these terms are not supported by applicants' specification; further, these limitations would require new search and consideration. Also given the fact that the Examiner is not entering the present amendment, it is clear that the prior art continues to meet the claims.

Conclusion

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to GERARD T. HIGGINS whose telephone number is (571)270-3467. The examiner can normally be reached on M-F 9:30am-7pm est. (1st Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho can be reached on 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Gerard T Higgins
Examiner
Art Unit 1794

/Gerard T Higgins/
Examiner, Art Unit 1794

/Callie E. Shosho/
Supervisory Patent Examiner, Art Unit 1794

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